

Serial No.: 10/734,022
Filed: December 11, 2003

Customer No.: 26,289
Attorney Docket: 2003US312

Remarks

The Examiner has rejected claim 5 and claim 12 under 35 USC 112 as not particularly pointing out and distinctly claiming the subject matter which the applicant regards as his own.

The Examiner has also rejected claims 1-2, 4-10, and 13-17 under 35 USC 102(e) as being anticipated by Nishi et al (US 6, 531,627). The Examiner has further rejected claims 1,3 and 6-17 under 102(e) as being anticipated by Nishiyama (US 2004/0063827) and Nakao (US 2004/0087694), claims 1,3,6-10 and 13-17 as being anticipated by Nishimura et al (US 2003/0219680).

The Examiner has also rejected Claims 11-12 under 35 USC 103(a) as being unpatentable over Nishi et al (US 6, 531,627) as applied to claims 1-2, 4-10 and 13-17, and further in view of by Nishiyama (US 2004/0063827). The Examiner has further rejected claims 11-12 under 35 USC 103(a) as being unpatentable over Nishimura et al (US 2003/0219680) as applied to claims 1-2, 4-10 and 13-17, and further in view of by Nishiyama (US 2004/0063827).

The applicants have amended claim 1 to cover a polymeric unit comprising the unit of structure 1 in the amended claim 1. Support for the amended structure is in the specification on page 10, line 13. Similarly claims 16 and 17 have been amended, and new claims 18-25 have been added. Support for the new claims is on page 8 line 25 to page 9 line 16, page 10 lines 14-15, and page 11, structure 4. Claim 12 has been amended to correct the dependency.

Nishi discloses a polymer comprising a cyclic backbone. The present invention comprises a unit with a noncyclic polymeric backbone.

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Nishiyama illustrates a monomeric unit of formula (Ia-25) where the two ester groups are bridged by an ethylene (CH_2CH_2) group, and this formula is one of a vast number of monomeric units disclosed in the invention. In fact, more than 34 individual monomeric structures with pendant ester groups containing a cyclic moiety are disclosed, although numerous more are described as possible monomeric units. The present invention claims a bridging group, W, which is a (C₁-C₈) linear or branched alkyl group. There is no teaching in Nishiyama that would lead one to believe that one specific monomeric unit, containing the bisester group is unique over the numerous others disclosed, especially one where the bridging group is (C₁-C₈) linear or branched alkyl. Eighteen resins were synthesized by Nishiyama, but not one of the monomers has the bisester structure as disclosed in the present invention, let alone the structure of claim 1. Furthermore, the specification provides no preference for the bisester monomer over the numerous others disclosed. Thus, there is no motivation in Nishiyama for one of ordinary skill in the art to lead one to choose a monomeric unit which has a bisester group, and especially one where the bridging group between the bisester groups is (C₁-C₈) linear or branched alkyl group. Similarly, Nakao does not also disclose or make obvious the (C₁-C₈) linear or branched alkyl bridging group of the present invention.

Nishimura teaches a group between the bisesters, U, which is a divalent bridged hydrocarbon group having 5-20 carbon atoms. In the presently amended claims the bridging group is (C₁-C₈) linear or branched alkyl group, and so is not taught by Nishimura.

Since Nishi, Nishiyama and Nishimura do not disclose the present invention or make it obvious, they cannot be combined to make claims 11-12 obvious.

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In view of the above amendments and remarks, the present application is believed to be in condition for allowance, and reconsideration of it is requested. If the Examiner disagrees, she is requested to contact the agent for Applicants at the telephone number provided below.

As the total number of claims does not exceed the number of claims originally paid for, no fee is believed due. However if an additional fee is required, the Commissioner is hereby authorized to credit any overpayment or charge any fee deficiency to Deposit Account No. 50-3309.

Additionally, the Commissioner is hereby authorized to charge the fee for a 2 month extension of time to Deposit Account No. 50-3309.

Respectfully submitted,



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